

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:
MARTIN GROHMAN
Serial No.: 10/634,497
Filed: August 5, 2003
GROOVED DECKING BOARD

Docket No.: 34192
Confirmation No.: 8665
Group Art Unit No.: 3635
Customer No.: 23589
Examiner: Robert Canfield

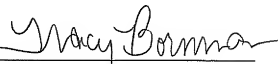
Assistant Commissioner of Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

STATEMENT

In accordance with Applicants' duty of candor toward the Office, Applicants previously advised the Examiner of the existence of U.S. Patent Application 10/634,499, filed August 5, 2003, entitled HIDDEN DECK FASTENER SYSTEM. An office action was mailed in the '499 application on September 27, 2006, in which several claims were rejected as being anticipated by one or more references. A copy of that action is enclosed.

Respectfully submitted,

By: 
Tracy L. Bornman, Reg. No. 42,347
HOVEY WILLIAMS LLP
2405 Grand Boulevard, Suite 400
Kansas City, MO 64108
(816) 474-9050

ATTORNEYS FOR APPLICANT(S)



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/634,499

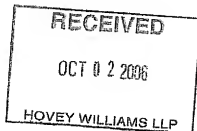
08/05/2003

Martin Grohman

33105

8662

7390 09/27/2006
HOVEY WILLIAMS LLP
Suite 400
2405 Grand Boulevard
Kansas City, MO 64108



EXAMINER

CANFIELD, ROBERT

ART UNIT

PAPER NUMBER

3635

DATE MAILED: 09/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

ALECTO

OCT 03 2006

ENTERED BY *sgm*

Office Action Summary

Application No.

10/634,499

Examiner

Robert J. Canfield

Applicant(s)

GROHMAN, MARTIN

Art Unit

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-40, 42-52 and 55-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-40, 42-52 and 55-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/31/06 has been entered. Claims 28-40, 42-52 and 55-61 are pending. Claims 1-27, 41, 53 and 54 have been canceled.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 28-40, 42-52 and 55-61 are rejected under 35 U.S.C. 102(a) as being anticipated by U.S. Patent 6,470,641 to Faure.

Faure provides first 12 and second 14 boards each having upper and lower lips separated by grooves 36/38 on opposite sides. The boards 12/14 are fastened to spaced joists 46 by metal fasteners 16. The fasteners 16 have a base 22 and a pair of protrusions 24/26 above the base at a height. The thickness of the lower lips or vertical distance to the grooves from the bottom of the boards is

greater than the distance between the base 22 and protrusions 24/26 of the fasteners 16 to provide pressure of the protrusions [bottom of column 2] to provide a holding force. The metal of the fasteners is inherently a resilient material.

5. Claims 28-30, 36 and 61 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 6,314,699 to West.

West provides first and second boards 16 each having upper and lower lips separated by grooves 18 on opposite sides. The boards 16 are fastened to spaced joists 14 by fasteners 12. The fasteners 12 have a base and a pair of protrusions 28/48 above the base at a height. The thickness of the lower lips 22 or vertical distance to the grooves from the bottom of the boards is greater than the distance between the base and tips 48 of protrusions 28 of the fasteners 16. While the tips 48 are not disclosed as bearing on the lower lips to provide an interference type fit they are operable to rigidly couple to the joists and are capable of doing so in an interference type manner if the gap between the boards was slightly increased. As such they are "operable to" exert a downward holding force as recited in claim 37 but do not "exert" a downward holding force as required in claim 31. Figure 1A appears to show at least about a 5% difference.

6. Applicant's arguments filed 08/31/06 with respect to the West '699 patent have been fully considered but they are not persuasive.

Applicant argues that West fails to provide the dimensions required to the protrusions to exert a downward force of the lower lips. Applicant is misinterpreting how the both the previous and instant examiner are defining "F" in order to meet the claims. "F" as applied to the claims is the distance from the bottom of fastener 12 to protrusions 48. This distance as shown in Figure 1A is clearly smaller than the distance "E" defined from the bottom of the boards 16 to the top of the lower lips 22 or the beginning of the grooves 18. While not disclosed as exerting a downward pressure of the lower lips 22 the protrusions 48 are quite capable of doing so if the spacing between the boards were slightly increased and as such are considered to meet the claims which have been rejected above.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Note the references listed on PTO-892 form that was attached to the Advisory Action mailed 08/28/06.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert J. Canfield whose telephone number is 571-272-6840. The examiner can normally be reached on M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Naoko Slack can be reached on 571-272-6848. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Robert J Canfield
Primary Examiner
Art Unit 3635

09/16/06

